



Paper No. 33

Chiron Corporation
Intellectual Property - R440
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JUL 25 2003

OFFICE OF PETITIONS

In re Application of
Duhl, et al.
Application No. 09/602,597
Filed: June 22, 2000
Attorney Docket No. 1568.002/200130.472
For: HUMAN CHROMOSOME 16
PLASMOLIPIN-LIKE POLYPEPTIDE

ON PETITION

This is a decision on the petition under 37 CFR 1.137(a), filed July 10, 2003, to revive the above-identified application. In the alternative, petitioner requests revival under 37 CFR 1.137(b).

The petition under 37 CFR 1.137(a) is **DISMISSED**.

The petition under 37 CFR 1.137(b) is **DISMISSED**.

The application file does not indicate a change of address has been filed in this case, although the address given on the petition differs from the address of record. A change of address should be filed in this case in accordance with MPEP 601.03. A courtesy copy of this decision is being mailed to the address noted on the petition. However, until otherwise instructed, all future correspondence regarding this application will be mailed solely to the address of record.

Any further petition to revive the above-identified application must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Petition under 37 CFR 1.137." This is **not** final agency action within the meaning of 5 U.S.C. § 704.

The above-identified application became abandoned for failure to file an appeal brief in triplicate following the May 2, 2002 filing of a Notice of Appeal (and amendment and affidavit). On May 31, 2002, the Office mailed an Advisory Action informing petitioner that the May 2, 2002 submissions did not place the application in *prima facie* condition for allowance. On October 17, 2002, an Examiner interview occurred in which no agreement with respect to the claims was reached. On November 4, 2002, petitioner submitted a request for a four month extension of time and required fee and another amendment. Unfortunately, this amendment was not reviewed until after the extended period for response expired. On February 13, 2003, the Office mailed an Advisory Action that informed petitioner that the November 4, 2002 amendment failed to place the application in *prima facie* condition for allowance. Since there were no allowed claims, the application became abandoned as of the date the brief was due. The above-identified application became abandoned on November 5, 2002, which is the day following the expiration of the original two month period for reply set by the filing of the Notice of Appeal plus the four month extension of time bought on November 4, 2002. On March 11, 2003, the Office mailed a Notice of Abandonment. Petitioner filed in the instant petition on July 10, 2003.

A grantable petition to revive an abandoned application under 37 CFR 1.137(a) must be accompanied by (1) the required reply, unless previously filed; (2) the petition fee as set forth in

§ 1.17(l); (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and (4) any terminal disclaimer (and fee as set forth in § 1.20 (d)) required pursuant to paragraph (c) of this section. This petition does not satisfy requirement (3).

Regarding (3), the showing of record is inadequate to establish unavoidable delay within the meaning of 37 CFR 1.137(a). Specifically, an application is "unavoidably" abandoned only where petitioner, or counsel for petitioner, takes all action necessary for a proper response to the outstanding Office action, but through the intervention of unforeseen circumstances, such as failure of mail, telegraph, telefacsimile, or the negligence of otherwise reliable employees, the response is not timely received in the Office. Ex parte Pratt, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887).

The Commissioner may revive an abandoned application if the delay in responding to the relevant outstanding Office requirement is shown to the satisfaction of the Commissioner to have been "unavoidable". 35 USC § 133. Decisions on reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable. Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887) (the term 'unavoidable' "is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business"); In re Mattullath, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition to revive an application as unavoidably abandoned cannot be granted where a petitioner has failed to meet his or her burden of establishing the cause of the unavoidable delay. Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (N.D. Ind. 1987).

In the instant case, petitioner has failed to provide adequate evidence that the delay was unavoidable. Petitioner asserts that the abandonment was caused by the Office's delay in reviewing the November 4, 2002 submission.

The showing presented is insufficient to establish unavoidable delay within the meaning of 35 USC 133 and 37 CFR 1.137(a). Petitioner filed a Notice of Appeal on May 2, 2002. The filing of the Notice of Appeal began a two month period to submit an appeal brief in triplicate. Petitioner chose to file amendments, rather than an appeal brief in triplicate. The amendments did not place the application in *prima facie* condition for allowance. The mere filing of an amendment does not relieve petitioner of the duty of taking appropriate action to save the application from abandonment. Although the PTO attempts to notify parties as to defective papers in order to permit timely refiling, it has no obligations to do so. See In re Colombo Inc., 33 USPQ2d 1530, 1532 (Comm'r Pat. 1994). Rather, it is the applicant who is ultimately responsible for filing proper documents. Id. A delay caused by an applicant's lack of knowledge or improper application of the patent statute, rules of practice or the MPEP is not rendered "unavoidable" due to the PTO's failure to advise the applicant of any deficiency in sufficient time to permit the applicant to take corrective action. See In re Sivertz, 227 USPQ 255, 256 (Comm'r Pat. 1985).

The petition under 37 CFR 1.137(a) is dismissed.

Petitioner requests revival under 37 CFR 1.137(b), in the alternative. However, petitioner has only authorized the Office to charge \$1,190 for the petition, which is \$1,300 {the 137(b) petition fee} - \$110 {the 137(a) petition fee}. Petitioner submitted the petition fee for the petition under 37 CFR 1.137(a) and received this decision. Now petitioner desires to file a petition under 37 CFR 1.137(b), without paying the full petition fee.

Petitioner is informed that the payment of the petition fee in full is a prerequisite to the filing of a petition to revive under 37 CFR 1.137(b). The phrase "[o]n filing" in 35 U.S.C. 41(a)(7) means that the petition fee is required for the filing (and not merely the grant) of a petition under 37 CFR 1.137. See H.R.Rep. No. 542, 97th Cong., 2d Sess. 6 (1982), *reprinted in* 1982 U.S.C.C.A.N. 770 ("[the fees set forth in this section are due on filing the petition]"). Accordingly, the Commissioner is statutorily precluded from further review of this petition, until the 1.137(b) petition fee is paid in full.

The petition under 37 CFR 1.137(b) is dismissed.

On other finance issues, it is noted that petitioner paid a five month extension of time with the instant petition. Pursuant to 37 CFR 1.136, an extension of time must be filed prior to the expiration of the maximum period obtainable for reply to avoid abandonment. Accordingly, since the \$ 530 extension of time submitted with the petition on July 10, 2003 was subsequent to the maximum period obtainable for reply, this fee is unnecessary and will be credited to petitioner's deposit account, no. 04-0258.

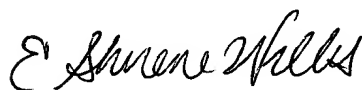
Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop PETITION
Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450

By hand: Crystal Plaza Four, Suite 3C23
2201 South Clark Place
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By Fax: (703) 308-6916
ATTN: Office of Petitions

Telephone inquiries pertaining to this matter may be directed to the undersigned at (703) 308-6712.



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